

Application No. 10/708,928
Amendment dated
Reply to Office Action of

Docket No.: 60680-1780

REMARKS

Applicants have carefully reviewed the Advisory Action dated October 19, 2005, and the Office Action mailed July 28, 2005. In response, Applicants have amended claims 7-8, and added new claims 9-21. By way of this amendment, no new matter has been added. Accordingly, claims 1, and 3-21 remain pending in this application. Applicants respectfully request reconsideration of the present application in view of the above amendment and following remarks.

New Claims

In support of newly added claims 9, 13, 16, 17, 18, and 20, Applicants note that at least paragraph [0012] and FIG. 1 illustrate the claimed limitations. In support of newly added claims 10, 11, 12, 14, 15, and 21, Applicants note that FIGS. 3-5 illustrate 12 fastener locations for coupling a first component, such as a valve cover, to a second component, such as an engine cylinder head. In support of newly added claim 19, Applicants note that paragraph [0014] describes the structure claimed. Applicants respectfully submit that the newly added claims are patentable over the prior art of record for at least the reasons presented in the remarks below and the remarks of the response dated September 28, 2005.

Advisory Action

The Examiner noted in the Advisory Action of October 19, 2005 that the Applicants' response of September 28, 2005 overcame the rejections within the Final rejection as to the §102 and §103 rejections over Hu. Furthermore, the Examiner maintained the §103 rejection of claims 1 and 3-8 over Baumann.

Claim Rejections – 35 U.S.C. § 103

Claims 1 and 3-8 were rejected under 35 U.S.C. § 103(a) as obvious over *Baumann* U.S. 4,684,103. Applicants respectfully traverse the rejection.

Modification of Prior Art

When rejecting a claim based upon a sole 35 U.S.C. 103(a) reference, the Federal has Circuit has provided some guidance. Specifically, *In re Gordon* provides that "[t]he mere fact

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that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." 221 USPQ 1125, 1127 (CAFC 1984). In addition, the Federal Circuit has held that "[i]t is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure." *In re Mills*, 16 USPQ2d 1430, 1433 (1990).

Independent claim 1 positively recites that "the fastener assembly acoustically decouples the components." Additionally, independent claim 7 positively recites that "the fastening system acoustically decouples the at least two components." In contrast, Baumann makes no mention of acoustically decoupling components. The Examiner provides, in the Advisory Action of October, 2005, when describing the teachings of Baumann, a portion of FIG. 1 of Baumann illustrating the housing 6 of Baumann as a "first engine component" and the metal diaphragm 25 of Baumann as a "second engine component". However, the housing 6 and the metal diaphragm 25 of Baumann cannot be acoustically decoupled. FIG. 1 of Baumann clearly illustrates the metal diaphragm 25 of Baumann secured between the housing 6 and the upper portion of the valve 24. Additionally, Baumann teaches that the valve retains pressures of 1,000 to 3,000 psi. (Baumann, column 1, lines 23-29) Accordingly, the seal between the housing 6 and the upper portion of the valve 24 must be sufficient to resist 3,000 psi. Indeed, one skilled in the art would recognize that Baumann *teaches away* from acoustically decoupling the housing 6 and the metal diaphragm 25, since the metal diaphragm 25 must be tightly secured to the housing 6. Thus, vibrations experienced in the housing 6 will be transmitted to the metal diaphragm 25. Therefore, Baumann does not teach each limitation of independent claims 1 and 7.

Furthermore, the Examiner identifies items 19, 22 and 30 of Baumann as a 'fastener assembly.' However, these components are not taught in Baumann as a fastener for anything. Specifically, Baumann mentions, in column 2, lines 64-68, that "displacement piston (19) may be configured in two parts; the lower one (30) of which has a threaded extension which can be screwed in or out of the upper portion of displacement piston (19) to effect a correction in distance." This quotation from Baumann reveals that items 19 and 30 are intended as a means to adjust the length of item 19, and not as a fastener. Accordingly, Applicants submit that one of skill in the art would not view the displacement piston 19 of Baumann as being useful as a

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fastener for acoustically decoupling two components. Accordingly, The Examiner has not met the burden of *In re Gordon*.

Non-Analogous

In re Oetiker presents a test for analogous art as "whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor." 24 USPQ2d, at 1445 (Fed. Cir. 1992). "In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must be either in the field of the applicant's endeavor, or, if not, reasonably pertinent to the particular problem with which the inventor was concerned." *Id.*

Baumann provides a mechanical amplifying means which may be used in place of hydraulic jacks or other hydraulic devices. (Baumann, column 1, lines 9-12) Applicants were concerned with acoustically decoupling at least two components. (Applicants' Specification, paragraph [0001]) Baumann does not present a solution for coupling two components while acoustically decoupling the components. Accordingly, Baumann is not within the field of the applicants' endeavor.

Additionally, Baumann is not reasonably pertinent to the particular problem with which the inventor was concerned. As mentioned above, Baumann teaches a mechanical amplifying means which may be used in place of hydraulic jacks or other hydraulic devices. The amplifying means is provided to overcome a pressure of 3,000 psi while not requiring springs 18 that can overcome the force exerted by a pressure of 3,000 psi. (Baumann, column 3, lines 9-13) Specifically, Baumann mentions that the metal diaphragm 25 provides a tight shut off of valve port 26 with about 1,000 lb exerted thereupon, and that there is no loose play within the device. (Baumann, column 3, lines 9-17) Accordingly, one skilled in the art would recognize that Baumann is of no use when seeking to reduce vibrations or acoustically decouple components.

Dependent claims 3-6 and 8 are also patentable by being dependent on an allowable base claim. Reconsideration and withdrawal of this rejection is respectfully requested.

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Conclusion

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1780 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

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Respectfully submitted,

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